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Knobbe Martens Olson & Bear LL  
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Newport Beach, CA 92660

EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT PAPER NUMBER

3676

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/789,630

Applicant(s)

TREMPALA, DOHN J.

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 15-17 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 1-7, 15-17, 24-30, 32, 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The amendment filed 9/27/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the limitation in claim 24 that "the key does not require a relief cut" is new matter since drawing Figure 6 clearly shows a relief cut in the narrow portion 102 disposed between the extension 108 and the handle 104.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 24-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claim 24 adding the limitation that the key does not require a relief cut is new matter since the drawings clearly show a relief cut in the narrow portion 102 disposed between the extension 108 and the handle 104.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3,32,33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoshino 5,419,650. Hoshino teaches a plug 21 and face plate 32 assembly for a pipe end 50 comprising a threaded actuator 70 having a configured head and attached to a tapered spreader member 41 which expands the plug member 21 into frictional engagement with the pipe walls 50 when locked. The plug comprises a front surface (at 51a in Fig.3), rear surface (at 21a in Fig.2), side surface (at 21a in Fig.1) and a slot 22 (fig.1) extending longitudinally between the front and rear and radially between the side and a relief opening (at 24 inside the plug) and further, wherein the inside of the plug forms a channel therethrough (coextensive with the surface 23 in Fig.1) and radially displaced from the relief opening (tapered portion 24), which receives a spreader member 41 and the actuator 70. With respect to new claim 32, the channel coextensive with surface 23 in Fig. 1 is clearly radially displaced from the relief opening (taper portion 24). With respect to new claim 33, the intended use of the device on a "fire department connection locking cap" is not accorded patentable weight since no

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additional structure is disclosed which would distinguish from the prior art locking cap and key and, therefor, the prior art key would be capable of being used on any cap having the claimed structure.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino '650 in view of Borenstein '771. Hoshino teaches a plug member on a locking cap but fails to specify the material used. Borenstein et al teach, in col. 4, line 65, the use of brass among other suitable materials for a plug lock member. It would have been obvious to one of ordinary skill in the art to modify the material of Hoshino by providing brass as taught by Borenstein et al as an obvious matter of design choice.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino '650 in view of Segal '110. Segal teaches the use of a bolt head 17 (Fig. 6) comprising at least 7 apexes and 8 wavy grooves actuated by a similarly configured key head. It would have been obvious to one of ordinary skill in the art to modify the bolt head 22 of Hoshino by providing a configured head and accompanying key head as taught by Segal to enhance the security of the lock.

6. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino '650 in view of Drach '193. Drach teaches a lock cap face plate having two

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spaced pin members 24,26 which are received in pin apertures 56,58 on a key member.

It would have been obvious to one of ordinary skill in the art to change the key configuration of the face plate 32 of Hoshino by providing pin members as taught by Drach since they are recognized art related equivalents.

7. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson '831. Patterson et al teach a key/tool member comprising a deformation zone which, upon torquing of the tool beyond a predetermined amount, deforms in a twisting manner. It would have been obvious to one of ordinary skill in the art to utilize such a tool/key having a socket wrench portion 115 as taught by Patterson et al, on a locking cap actuator such as that previously discussed with respect to Hoshino.

8. Claims 24,29 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Stehling '501 in view of Patterson '831. Stehling teaches a key member having a hole portion (at 40) which is capable of receiving a key ring. It would have been obvious to one of ordinary skill in the art to modify the key of Stehling by providing a deformation zone as taught by Patterson et al as an obvious matter of design choice in enhancing the security of the lock cap.

9. Claims 24,30 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Borenstein '771 in view of Patterson '831. Borenstein et al teach a key member comprising a T-shaped cross member configuration at one end (49/66) with a hole 66 disposed in one cross member. It would have been obvious to one of ordinary skill in the art to modify the key of Borenstein et al by providing a deformation zone as taught

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by Patterson et al as an obvious matter of design choice in enhancing the security of the lock cap.

***Allowable Subject Matter***

10. Claim 31 is allowed.

The new limitation in claim 31 requiring the channel to be disposed between the slot and the relief opening defines over Hoshino which clearly teaches the channel (portion coextensive with surface 23 in Fig.1) radially disposed after the slot 22 and relief opening (tapered portion 24).

***Response to Arguments***

11. Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive. As set forth above, the added limitation to claim 24 is considered new matter since drawing Figure 6 clearly discloses a relief cut between the extended portion 108 and the handle 104. Thus, with respect to claims 24-30, the Patterson rejection is maintained. Furthermore, it is noted that the Terminal Disclaimer has been approved, obviating the double patenting rejections. With respect to Hoshino, Applicant's arguments regarding the use of a single disclosed feature to satisfy two distinct limitations are not persuasive since Hoshino clearly teaches in Figure 1, a small tapered portion 24 at the front or upper surface of the plug which is being used to satisfy the relief opening structure, and a straight channel through the plug, coextensive from the inner surface 23 (i.e. a plane extending from the surface 23 straight through the plug and therefor, disposed radially inward of the tapered portion 24) to satisfy the channel

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structure. It is noted that the claims do not require that the relief opening extend completely through the plug, therefore the small tapered portion 24 of Hoshino satisfies this limitation. Accordingly, claims 1-7, 15-17, 24-30, 32, 33 stand rejected.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Suzanne Dino Barrett  
Primary Examiner  
Art Unit 3676

sdb